

DOCKET NO. US 010027
CLIENT NO. PHIL06-01428

PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Monisha Ghosh

Serial No.: 09/781,486

Filed: February 12, 2001

For: SYSTEM AND METHOD FOR SENDING LOW RATE
DATA ON A PACKET BASIS IN AN 8-VSB
STANDARD DATA PACKET STREAM

Group No.: 2613

Examiner: Allen C. Wong

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal.

STATUS OF THE CLAIMS

Claims 1-29 remain pending in the application.

Claims 1-4, 9, 10, 17, 18, 23, and 24 have been rejected.

Claims 5-8, 11-16, 19-22, and 25-29 have been objected to.

Reconsideration and full allowance of Claims 1-29 are respectfully requested.

REMARKS

In the November 23, 2005 Advisory Action, the Examiner maintains his previous rejections of Claims 1-4, 17-18 and 23-24 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,810,084 to Jun et al. ("Jun") in view of U.S. Patent No. 5,903,324 to Lyons et al. ("Lyons"); and of Claims 9-10 under 35 U.S.C. § 103(a) as being unpatentable over Jun in view of U.S. Patent No. 4,677,625 to Betts et al. ("Betts").

The Applicant respectfully submits: i) that there is no suggestion or motivation – without the benefit of hindsight reconstruction from the present application – to **speculatively and selectively** cull from and combine the reference teachings; and ii) that – even if one of **ordinary** skill in the art were so motivated - the proposed combinations of Jun and Lyons, and Jun and Betts, would still not result in the invention as recited in independent Claims 1, 9, 17 and 23. As such, the Examiner has failed to establish a *prima facie* case of obviousness.

Independent Claim 1 is reproduced here for the convenience of the review panel, as the Examiner has rejected Claims 1, 17 and 23 on substantially similar grounds:

1. A system for sending low rate data on a packet basis in an 8-VSB standard data packet stream, said system comprising:
an 8-VSB signal transmitter capable of transmitting a low rate data packet that comprises data bytes, each of one or more of the data bytes containing both information bearing bits and non-information bearing bits. (*Emphasis added*).

The Examiner has conceded "Jun does not disclose each of one or more of the data bytes containing both bearing [sic] and non-information bearing bits", as required by independent Claim 1. Applicant agrees.

Applicant submits that Jun neither teaches nor suggests a data byte "containing both information bearing bits and non-information bearing bits", nor any reason why such a byte structure might be necessary or desirable. Furthermore, Applicant submits that Jun appears – at the packet level – to teach away from non-

information bearing packets. Jun teaches and suggests the desirability of substituting training data (i.e., information) for null packets. (Col. 3, lines 23-24; Col. 9, lines 30-32).

The Examiner further concedes that Lyons instead discloses “each one or more of the data bytes contain important data and non-important data.” The Examiner appears to equate two types of information (i.e., data) – important and non-important – to information and no information. Applicant respectfully submits that non-important information is not equivalent to no information.

Applicant respectfully submits that one of ordinary skill, having only Jun before him, would not be prospectively moved to spontaneously: 1) Evaluate Jun and understand it, including its apparent teaching – at the packet level – of substituting data (i.e., information) for null packets; 2) spontaneously decide that only that portion of the Jun reference was wrong, and that – at a bit level – it would be desirable to have both information and non-information bits within a single byte; 3) seek out and find the Lyons reference; 4) speculatively read into the Lyons reference an equivalency between important data and information, and between non-important data and no information; 4) speculatively and selectively cull from Lyons a byte structure based upon such an equivalency; and 5) successfully modify Jun’s packet level operations and constructs to function on a bit level to integrate the inferred Lyons byte structure.

In the rejection of Claim 9, the Examiner again concedes deficiencies of Jun and attempts to, through improper hindsight combination with – and creative interpretation of – Betts, overcome these admitted deficiencies of Jun.

Again, Applicant respectfully submits that one of ordinary skill, having only Jun before him, would not be prospectively moved to spontaneously: 1) Evaluate Jun and understand it, including its explicit teaching against the provision of null packets to the data interleaver; 2) disregard that teaching and spontaneously decide that the system of Jun needed to implement switches; 3) seek out and find the Betts reference; 4) selectively

cull two switching circuits from Betts, disregarding the rest of Betts architecture – including Betts' randomizer, multiple trellis encoders, and QAM encoder – and operations directed toward a different issue; and 5) successfully modify Jun's architecture and operations to incorporate switching circuits that perform a function contrary to Jun's own teachings.

As such, Claims 1, 9, 17 and 23 distinguish over the improper hindsight combinations of Jun with Lyons and Betts. As a result, Claim 1-29 are all believed to be allowable.

For these reasons, the Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness and, without more, the Applicant is entitled to grant of a patent.

Respectfully submitted,

MUNCK BUTRUS P.C.

Date:

July 31, 2006

P.O. Drawer 800889

Dallas, Texas 75380

Tel: (972) 628-3600

Fax: (972) 628-3616

E-mail: wmunck@munckbutrus.com



William A. Munck

Registration No. 39,308